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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/479,979	01/10/2000	WILLIAM HILL	13237-1701/M	3757

28319 7590 12/04/2003

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EXAMINER

HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 12/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/479,979

Applicant(s)

HILL ET AL.

Examiner

Cong-Lac Huynh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 35-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is responsive to communications: request for reconsideration filed 9/8/03 of application filed on 01/10/00 which is a continuation of the application 08/847,427 filed on 4/24/97, now US Pat No. 6,023,714.

2. Claims 35-53 are pending in the case. Claims 35, 42 and 48 are the independent claims.

3. In response to Applicants' arguments, Examiner provides two articles to show that Spyglass Prism was available to public in December 1996 prior March 1997 as provided in the previous office action.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103 ( c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 35-53 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Spyglass Prism, *Concepts and Applications* (pages 1-8) and *Spyglass Prism 1.0* (pages 1-2), 3/1997 (referred as Spyglass) in view of Carliner, *Elements of Editorila Style for Computer-Delivered Information*, IEEE, March 1990, pages 38-45.

Regarding independent claim 35, Spyglass discloses:

- determining a set of capabilities of the output device (Spyglass Prism, *Concepts and Applications*, page 2, once connected *the device identifies itself* and the user via the User Database used to track information such as user preferences and the *Device Database containing the characteristics of various devices* such as resolution, color or monochrome support, text or graphics display; Spyglass Prism 1.0, page 2, identifies the user and the device...run the content through the series of conversion routines to convert the content into a format appropriate to that device)
- formatting the document for presentation on the output device (Spyglass Prism, *Concepts and Applications*, page 2, automatically massages Web content into a format that matches the capabilities of the requesting device)

Spyglass does not disclose selecting one of a plurality of style sheet based upon the set of capabilities of the output device.

Carliner discloses the style sheets for writing computer delivered information where the targets of delivering information are different output devices such as different computer displays or printers with different capabilities (page 39, section "Why computer-delivered information needs its own style").

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Carliner to include selecting one of a plurality of style sheet based upon the set of capabilities of the output device for the following reason. Writing computer-delivered information using the style sheets for formatting the information where the information is rendered differently on different output devices suggests that an appropriate style sheet be selected to match the characteristics of the output device.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Carliner into Spyglass since Carliner provides the style sheets for delivering computer information to different output devices either to a computer display or a printer and Spyglass provides determining the capabilities of an output device connected to a computer. The combination of Carliner into Spyglass would provide a method for formatting a document according to the style sheet that can be changed to match the characteristics of the output device. In other words, said style sheet is selected based on the capabilities of the output device.

Regarding claim 36, which is dependent on claim 35, Spyglass does not disclose explicitly that a layout generator is used for determining a set of the capabilities of the

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output device and selecting one of a plurality of style sheets based upon the set of capabilities of the output device.

However, Spyglass does teach determining a set of the capabilities of the output device and Carliner provides style sheets used for writing computer-delivered information to obtain different views in different output devices with different capabilities (as mentioned in claim 35).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Spyglass and Carliner to include a layout generator since the style sheets for different output devices in Carliner suggests selecting an appropriate style sheet for an output device when writing document. Spyglass discloses determining the capabilities of the output device. The combination of Spyglass and Carliner, therefore, suggests the functions of a layout generator as claimed.

Regarding claims 37, 44-45, 50, which are dependent on claims 35, 42, 48, respectively, Spyglass does not disclose that the layout generator is external to the document.

Carliner discloses editors for resolving questions about style sheets of documents and output devices (page 38: "You've been asked ... who write printed materials, not computer-delivered information).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Carliner to include the external feature to the document of

the layout generator since modifying the style sheet is performed using editors, *outside* the document.

Regarding claims 38-41, 46-47, 49-52, which are dependent on claims 35, 42, 48, respectively, Spyglass does not disclose embedding the style sheet in the document, placing a style tag corresponding to the selected style sheet in the document, wherein the document includes a plurality of tags and embedding the selected style sheet comprises placing style attributes corresponding to the selected style sheet in the tags of the document.

Carliner discloses reading a hypertext document (pages 39-40: "readers usually read books ... when reading a hypertext document, one reader might start with ... when *writing computer-delivered information* ... for more information). Carliner further discloses different stylistic elements of computer-delivered information when writing computer-delivered information (page 39, section "why computer-delivered information needs its own style").

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Carliner into Spyglass for the following reason. The fact that Carliner discloses reading a hypertext document and writing computer-delivered information using style sheets suggests writing hypertext using style sheets since it was well known that a hypertext document is written using tags and since the style sheets are applied in the hypertext tags. Accordingly, it is suggested that the style sheets

selected for the document to be delivered to an output device be embedded in the tags in writing the hypertext document.

Independent claim 42 includes limitations of claim 35, and is rejected under the same rationale except the limitations: selecting *a layout generator* and generating the selected style sheet based upon the set of capabilities of the output device *using the layout generator*.

Spyglass discloses automatically massaging web content into a format that matches the capabilities of the requesting device (Concepts and Applications, page 2).

Carliner discloses the style sheets for writing computer-delivered information that may be delivered to a computer display or a printer for printing where a computer display and a printer have different capabilities (page 39, section "Why computer-delivered information needs its own style").

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Carliner into Spyglass for obtaining a method of formatting a document that matches the capabilities of the output device using the style sheet selected based upon the set of capabilities of the output device.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Carliner and Spyglass to incorporate selecting a layout generator for generating the selected style sheet based upon the set of capabilities of the output device. The fact that the format of a web document is manipulated to match the capabilities of the output device and the style sheet of a document, which is merely the format, can be adapted for different output devices show that the style sheet of the document is selected for matching the capabilities of the output device. In other words, generating the selected style sheet based upon the



capabilities of the output device is inherently performed in adapting the format of web documents to different output devices as the function of the layout generator.

Regarding claim 43, which is dependent on claim 42, as mentioned in claim 42, Spyglass and Carliner do not explicitly disclose that the layout generator is a general purpose layout generator for use with a plurality of documents.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Spyglass and Carliner to include a general purpose layout generator since Carliner provides *different style sheets for computer-delivered information where the targets for delivering information are* different output devices with different capabilities. The layout generator is suggested as a general purpose layout generator for use with a plurality of documents since documents in Carliner can be in different types (page 38: "you're been asked to write a computer-based training lesson, hypertext stack, or some other types of information delivered on a computer").

Regarding independent claim 48, the claim includes the limitations as in claims 35 and 42 except interrogating the output device to determine a set of capabilities of the output device. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Spyglass and Carliner to add interrogating the output device to determine a set of capabilities of the output device since said interrogating is inherently included in "determining a set of capabilities of the output

device" which is mentioned in claim 35. The reason is that the system should question the output device to find out the capabilities the output device has.

Regarding claim 53, Spyglass and Carliner disclose that the document is a markup language document (Spyglass: Concepts and Applications, page 2, "...messages Web content into a format ..."; Carliner, pages 38, 39: delivered information can be hypertext document).

### ***Response to Arguments***

7. Applicant's arguments filed 9/8/03 have been fully considered but they are not persuasive.

Applicants argue that the mere fact Spyglass Prism product was announced on March 10, 1997 does not evidence that an enabling disclosure was available to the public as of that date.

Since Applicants argue that the date of the product was not true, Examiner further provides two articles:

- Spyglass unveils servers for the future – the Web, on Electronic News, Dec 16, 1996, Vol. 42, pg 44
- Spyglass' strategy for the World Wide Web: [Computimes, 2\* Edition], on New Straits Times Dec 12, 1996, page 16

enclosed with the office action to show that Spyglass Prism was available to public in December 1996 prior March 1997 as provided in the previous office action.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9000.

clh  
11/28/03

  
STEPHEN S. HONG  
PRIMARY EXAMINER